


PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|--|
| In re the Patent Application of: | Group Art Unit: 1612 |
| Applicants: Jeffrey P. Walker, et al. | Examiner: Gollamudi S Kishore |
| Serial No.: 09/387,219 | WSGR Reference No.: 34149-703.401 |
| Filed: August 31, 1999 | Confirmation No.: 2344 |
| Title: <i>Drug Delivery System and Method</i> | <hr/> <p style="text-align: center;"><u>Certificate of Mailing or Transmission</u></p> <p>I hereby certify that this correspondence and all marked attachments is being transmitted by facsimile on June 24, 2009 to the United States Patent and Trademark Office at (571) 273-0025.</p> <p>By:  Misty Elam</p> |

REQUEST FOR WITHDRAWAL OF ABANDONMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This response is a request for withdrawal of the abandonment that was mailed on May 11, 2009 (Abandonment). Applicants submit that the application was held abandoned in error, and hereby request withdrawal of the Abandonment, and examination of the pending claims.

Remarks begin on page 2 of this paper.

REMARKS

In response to the Abandonment mailed May 11, 2009, Applicants respectfully submit that the application was erroneously abandoned, and request that the Abandonment be withdrawn and the application returned to a pending status.

The reason given for holding the application abandoned was that Applicants had failed to respond to an office action. However, the Applicants filed a Continued Prosecution Application (CPA) on July 31, 2001; and under CPA practice, Applicants were not required to file a response to an office action in order for the CPA to be complete. *See* MPEP § 201.06(d), 7th Ed., Rev. 1 (Feb. 2000); *see also* 37 CFR 1.53(d).¹ Accordingly, the reason given for holding the application abandoned was erroneous. As Applicants complied with the requirements of the CPA rule that was in force at the time that the CPA was filed, they request that the Abandonment be withdrawn and that the application be returned to a pending status.

Applicants filed a Continued Patent Application (CPA) on July 31, 2001. While there was considerable correspondence and telephone communication between the Office and Applicants' counsel regarding filing fees, there was never any allegation that the conditions for filing a CPA had not been met until the Abandonment was mailed on May 11, 2009. Indeed, Applicants submit that all the requirements for filing a CPA have been met, and that the application should properly be pending before the Office.

The rule governing filing of a CPA, which was in force when Applicants' filed their CPA, is 37 CFR § 1.53(d), which states in pertinent part: "A continuation ... application ... of a prior nonprovisional application may be filed as a continued prosecution application provided that:

"(i) The prior nonprovisional application is

(A) Complete as defined by § 1.51(b); ... and

"(ii) The application under this paragraph is filed before the earliest of:

"(A) Payment of the issue fee....,

"(B) Abandonment of the prior application; or

¹ For the Examiner's convenience, a copy of M.P.E.P. § 201.06(d), 7th Ed., Rev. 1, which was in force on July 31, 2001, when the CPA was filed, is attached hereto as Exhibit A. The text of 37 C.F.R. § 1.53 from MPEP 7th Ed., Rev. 1, is attached as Exhibit B.

“(C) Termination of proceedings on the prior application.”

There has been no allegation made that Applicants failed to meet the requirements for a CPA under 37 CFR § 1.53(d), nor do Applicants believe any such allegation would be true. The prior application of the same serial number was complete; and the CPA was filed prior to payment of the issue fee, abandonment and/or termination of the proceedings in the prior application. Applicants note that the current version of the MPEP, which was in force when the Abandonment was mailed, states, “CPAs filed prior to July 14, 2003 will continue to be processed and examined under the procedures set forth in prior 37 CFR 1.53(d).” MPEP § 201.06(d), 8th Ed., Rev. 7, 200-31 (Aug. 2006). Accordingly, failure to examine the application as a properly filed CPA under 37 CFR § 1.53(d) was improper. As Applicants have complied with the requirements for a CPA, Applicants submit that the Abandonment was erroneous and should be withdrawn. Such action is respectfully requested.

CONCLUSION

In view of the remarks and amendments submitted herein, Applicants submit that the application is order for examination, and such action is earnestly solicited.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2312.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation



Peter R. Munson
Attorney for Applicants
Registration No. 43,821

Dated: June 23, 2009

650 Page Mill Road
Palo Alto, CA 94304-1050
Direct Dial: (858) 350-2337
Customer No. 21971

Exhibit A MPEP 201.06(d)

7th Ed., Rev. 1, Feb. 2000

201.06(d)

MANUAL OF PATENT EXAMINING PROCEDURE

ABANDONMENT OF THE PRIOR NONPROVISIONAL APPLICATION

Under 37 CFR 1.53(b) and 37 CFR 1.63(d) practice, the prior nonprovisional application is not automatically abandoned upon filing of the continuing application. If the prior nonprovisional application is to be expressly abandoned, such a paper must be signed in accordance with 37 CFR 1.138. A registered attorney or agent not of record acting in a representative capacity under 37 CFR 1.34(a) may also expressly abandon a prior nonprovisional application as of the filing date granted to a continuing application when filing such a continuing application.

If the prior nonprovisional application which is to be expressly abandoned has a notice of allowance issued therein, the prior nonprovisional application can become abandoned by the nonpayment of the issue fee. However, once an issue fee has been paid in the prior application, even if the payment occurs following the filing of a continuing application under 37 CFR 1.53(b) and 37 CFR 1.63(d), a petition to withdraw the prior nonprovisional application from issue must be filed before the prior nonprovisional application can be abandoned (37 CFR 1.313).

If the prior nonprovisional application which is to be expressly abandoned is before the Board of Patent Appeals and Interferences, a separate notice should be forwarded by the appellant to the Board, giving them notice thereof.

After a decision by the Court of Appeals for the Federal Circuit (CAFC) in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the Patent and Trademark Office. *Continental Can Company, Inc. v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). See MPEP § 1216.01.

EXAMINATION

The practice relating to making first action rejections final also applies to continuation and divisional applications filed under 37 CFR 1.53(b) and 37 CFR 1.63(d). See MPEP § 706.07(b).

Any preliminary amendment filed with a 37 CFR 1.53(b) application which is to be entered after granting of the filing date should be entered by the technical support personnel of the patent examining group where the application is finally assigned to be examined. Any errors in the numbering of claims in preliminary amendment(s) can be corrected in the patent examining groups. Accordingly, these applications should be classified and assigned to the proper patent examining group by taking into consideration the claims that will be before the examiner upon entry of such a preliminary amendment.

If the examiner finds that pages of the specification or drawings figures described in the specification are missing

and the application is a continuation or divisional application filed under 37 CFR 1.53(b) using a copy of the oath or declaration filed in the prior application under 37 CFR 1.63(d), the examiner must check to determine whether the continuation or divisional application, as originally filed, includes a statement incorporating by reference the prior application(s). The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit applicant to amend the continuation or divisional application to include any subject matter in the prior application(s) without the need for a petition. If the continuation or divisional application filed under 37 CFR 1.53(b) and 37 CFR 1.63(d) does not include the incorporation by reference statement in the application papers as originally filed and applicant has not been informed of the omitted items, the application should be returned to OIPE for mailing of a "Notice of Omitted Item(s)."

201.06(d) 37 CFR 1.53(d) Continued Prosecution Application (CPA) Practice [R-1]

37 CFR 1.53. Application number, filing date, and completion of application.

(d) Application filing requirements - Continued prosecution (non-provisional) application.

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

- (i) The prior nonprovisional application is either:
 - (A) Complete as defined by § 1.51(b); or
 - (B) The national stage of an international application in compliance with 35 U.S.C. 371; and
- (ii) The application under this paragraph is filed before the earliest of:

- (A) Payment of the issue fee on the prior application, unless a petition under § 1.313(b)(5) is granted in the prior application;
- (B) Abandonment of the prior application; or
- (C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

- (i) Must identify the prior application;
- (ii) Discloses and claims only subject matter disclosed in the prior application;
- (iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;
- (iv) Includes the request for an application under this paragraph, will utilize the file jacket, and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and
- (v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee for a continued prosecution application filed under this paragraph is:

- (i) The basic filing fee as set forth in § 1.16; and
- (ii) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application.

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

- (i) Title of invention;
- (ii) Name of applicant(s); and
- (iii) Correspondence address.

(9) Envelopes containing only requests and fees for filing an application under this paragraph should be marked "Box CPA." Requests for an application under this paragraph filed by facsimile transmission should be clearly marked "Box CPA."

IN GENERAL

In addition to the provisions of 37 CFR 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 CFR 1.53(d). A continuation or divisional application filed under 37 CFR 1.53(d) is called a "Continued Prosecution Application" or "CPA." A CPA has a number of advantages compared to a continuation or divisional application filed under 37 CFR 1.53(b).

For example, the papers required to be filed in the Patent and Trademark Office in order to secure a filing date under 37 CFR 1.53(d) are minimal compared to 37 CFR 1.53(b). In addition, the Office will not issue a new filing receipt for a CPA. See 37 CFR 1.54(b). By not issuing a filing receipt for a CPA, the Office will be able to perform the pre-examination processing of any CPA in the patent examining group to which the prior application was assigned. A CPA may also be filed by facsimile transmission or by hand-delivery directly to the patent examining group to which the prior application was assigned. The use of these techniques for filing a CPA will avoid the delay inherent in routing a new application from the Office of Initial Patent Examination (OIPE) to the appropriate patent examining group. As a result, the time delay between the filing date and the first Office action should be less for a CPA than for an application filed under 37 CFR 1.53(b). >The PTO will treat continuation CPAs, for examination priority purposes only, as if they were "amended" applications (as of the CPA filing date) and not as "new" applications. As "amended" applications generally have a shorter time frame for being acted on by examiners than "new" applications, this treatment (of CPAs as "amended" applications) will result in first Office actions being mailed in continuation CPAs much sooner than if they had been filed as continuations under 37 CFR 1.53(b) (or under former 37 CFR 1.60 or 1.62). Therefore, applicants are strongly encouraged to file any preliminary amendment in a CPA at the time the CPA is filed.<

A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 CFR 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 CFR 1.53(b). >If applicant wants the PTO to disregard a previously filed request for a CPA (and not recognize its inherent request to expressly abandon the prior application) and to treat the paper as the filing of an application under 37 CFR 1.53(b), the applicant must file a petition under 37 CFR 1.182. A request to expressly abandon an application is not effective until the abandonment is acknowledged, including the express abandonment of the prior application of a CPA that occurs by operation of 37 CFR 1.53(d)(2)(v). The express abandonment of the prior application is acknowledged and becomes effective upon processing and entry of the CPA into the file of the prior application. Thus, such a petition under 37 CFR 1.182 should be filed expeditiously since the petition will not be granted once the request for a CPA has been entered into the prior application (and the inherent request to expressly abandon the prior application has been acknowledged). If the request for a CPA has been entered into the prior application by the time the petition under 37

CFR 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied. It is noted, however, that if the applicant intended to file a second application (either a continuation or a divisional) without abandoning the prior application, applicant can still achieve that result without loss of the benefit of the original filing date by: (1) continuing the prosecution of the original application via the CPA; and (2) filing a new continuation/divisional under 37 CFR 1.53(b) claiming benefit of the CPA and its parent applications under 35 U.S.C. 120 during the pendency of the CPA.<

The CPA procedure set forth in 37 CFR 1.53(d) is available for "utility," design, plant, and reissue applications when filing either a continuation or divisional application of the same type ("utility," design, plant, reissue) as the prior nonprovisional application. Since no new matter may be introduced in a CPA, the procedure set forth in 37 CFR 1.53(d) is not available for filing a continuation-in-part application. All continuation-in-part applications must be filed under 37 CFR 1.53(b) and a newly executed oath or declaration is required.

Under the CPA procedure, the continuation or divisional application will utilize the file wrapper and contents of the prior nonprovisional application, including the specification, drawings and oath or declaration from the prior nonprovisional application, and will be assigned the same application number as the prior nonprovisional application. No filing receipt will be mailed by the Patent and Trademark Office for the CPA. Any changes to the continuation or divisional application desired when filing the CPA must be made in the form of an amendment to the prior application as it existed prior to filing the CPA, see 37 CFR 1.53(d)(5). Any new specification filed with the CPA request will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with 37 CFR 1.125. However, the applicant must comply with the requirements of 37 CFR 1.125(b) before the substitute specification will be entered into the CPA. >Since 37 CFR 1.125(b) requires that a substitute specification be accompanied by, *inter alia*, a statement that the substitute specification includes no new matter, any substitute specification containing new matter will be denied entry by the examiner. Any preliminary amendment to the written description and claims, other than a substitute specification, filed with a CPA request will ordinarily be entered. Any new matter which is entered, however, will be required to be canceled pursuant to 35 U.S.C. 132 from the descriptive portion of the specification. Further, any claim(s) which relies upon such new matter for support will be rejected under 35 U.S.C. 112, first paragraph. See MPEP § 2163.06. In the event that a substitute specification or preliminary amendment containing new matter was

filed with a request for a CPA, applicant may file a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the request for a CPA and substitute specification/preliminary amendment were filed. Of course, a request for a CPA is not improper simply because the request is accompanied by a substitute specification or preliminary amendment containing new matter. Thus, an applicant will not be entitled to a refund of the filing fee paid in a proper CPA as a result of the granting of a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file.<

A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 CFR 1.51(b). There is no limit to the number of CPAs that may be filed in a chain of continuing applications. However, only one CPA may be pending at one time based on the same prior nonprovisional application.

Under 37 CFR 1.53(d), the specification, claims, and drawings, and any amendments entered in the prior nonprovisional application are used in the CPA. A new filing fee is required in accordance with 35 U.S.C. 41 and 37 CFR 1.16. The only other statutory requirement under 35 U.S.C. 111(a) is a signed oath or declaration. Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under the statute and rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration will be considered to be the oath or declaration of the CPA.

The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter.

Envelopes containing only requests and fees for filing a CPA should be marked "Box CPA" and requests for a CPA filed by facsimile transmission should be clearly marked "Box CPA." See 37 CFR 1.53(d)(9).

If application papers are in any way designated as a CPA filing under 37 CFR 1.53(d) (e.g., contain a reference to 37 CFR 1.53(d), CPA, or continued prosecution application), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even if the application papers also contain other inconsistent designations (e.g., if

the papers are also designated as an application filed under 37 CFR 1.53(b)).

CONDITIONS FOR FILING A CPA

A continuation or divisional application may be filed under 37 CFR 1.53(d), if the prior nonprovisional application is either: (1) complete as defined by 37 CFR 1.51(b); or (2) the national stage of an international application in compliance with 35 U.S.C. 371. The term "prior nonprovisional application" in 37 CFR 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 CFR 1.51(b) and a "national stage of an international application in compliance with 35 U.S.C. 371" must each contain, *inter alia*, the appropriate filing fee and a signed oath or declaration under 37 CFR 1.63.

In addition, a continuation or divisional application filed under 37 CFR 1.53(d) must be filed before the earliest of: (1) payment of the issue fee on the prior application, unless a petition under 37 CFR 1.313(b)(5) is granted in the prior application; (2) abandonment of the prior application; or (3) termination of proceedings on the prior application.

INITIAL PROCESSING

A CPA request will be initially processed by the patent examining group assigned the prior application. The patent examining group will verify that (1) the prior application is a nonprovisional application, (2) the correct application number of the prior nonprovisional application is identified in the request, (3) the request is properly signed, (4) the prior nonprovisional application was pending on, and that the issue fee has not been paid in the prior nonprovisional application on or prior to, the filing date of the CPA request, (5) the prior nonprovisional application was complete under 37 CFR 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under 37 CFR 1.63 has been filed in the prior application), and (6) the proper filing fee has been paid in the CPA. If one or more conditions for filing a CPA have not been satisfied or the proper filing fee has not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper filing fee submitted. See 37 CFR 1.53(h). If an examiner discovers that an improper or incomplete CPA has been forwarded to the examiner in error, the application should be immediately returned to a supervisory applications examiner (SAE) within the patent examining group. The improper or incomplete CPA is not to be returned to OIPE.

INCORRECT PARENT APPLICATION NUMBER IDENTIFIED

A request for a CPA must identify the prior nonprovisional application (37 CFR 1.53(d)(2)(i)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the patent examining group should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the patent examining group is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. If the patent examining group is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the patent examining group to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the Patent and Trademark Office with the correct application number within two weeks of the mail date on the cover letter, the original date of receipt of the CPA request will be considered by the Patent and Trademark Office as the date of receipt of the CPA request. See 37 CFR 1.5(a). A copy of the returned CPA request and a copy of the date-stamped cover letter should be retained by the patent examining group. Applicants may use either the Certificate of Mailing or Transmission procedure under 37 CFR 1.8 or the "Express Mail" procedure under 37 CFR 1.10 for resubmissions of returned CPA requests if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned CPA request is not resubmitted within the two-week period with the correct application number, the patent examining group should cancel the original "Office Date" stamp on the CPA request and re-stamp the returned CPA request with the date of receipt of the resubmission or with the date of deposit as "Express Mail" with the United States Postal Service, if the CPA request is resubmitted under 37 CFR 1.10. Where the CPA request is resubmitted later than two weeks after the return mailing by the Patent and Trademark Office, the later date of receipt or date of deposit as "Express Mail" of the resubmission will be considered to be the filing date of the CPA request. The two-week period to resubmit the

returned CPA request is not extendible. See 37 CFR 1.5(a).

In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for a CPA the following information relating to the prior application to the best of his or her ability: (1) title of invention; (2) name of applicant(s); and (3) correspondence address. See 37 CFR 1.53(d)(8).

SIGNATURE REQUIREMENT

A CPA is a request to expressly abandon the prior application (37 CFR 1.53(d)(2)(v)) and, therefore, must be properly signed. For a listing of the individuals who may properly sign a CPA request, see 37 CFR 1.33(b). In a joint application with no attorney or agent, all applicants must sign the CPA request in order for the CPA request to be considered properly signed. An unsigned or improperly signed CPA request will be placed in the file of the prior application, and is entitled to an application filing date, but is ineffective to abandon the prior application. A CPA will **NOT** be examined until the CPA request is properly signed.

A request for a CPA may be signed by a registered practitioner acting in a representative capacity under 37 CFR 1.34(a). However, correspondence concerning the CPA will be sent by the Office to the correspondence address as it appears in the prior nonprovisional application until a new power of attorney, or change of correspondence address signed by an attorney or agent of record in the prior application, is filed in the CPA.

A request for a CPA may also be signed by the assignee or assignees of the entire interest. However, the request must be accompanied by papers establishing the assignee's ownership under 37 CFR 3.73(b), unless such papers were filed in the prior application and ownership has not changed.

FILING DATE

The filing date of a CPA is the date on which a request on a separate paper for a CPA is filed. A request for a CPA cannot be submitted as a part of papers filed for another purpose, see 37 CFR 1.53(d)(2), (e.g., the filing of a request for a CPA within an amendment after final for the prior application is an improper request for a CPA).

A paper requesting a CPA may be sent to the Patent and Trademark Office by mail (see MPEP § 501), by facsimile transmission (see MPEP § 502.01) or it may be filed directly at the Attorney's Window located in Room 1B03 of Crystal Plaza 2, 2011 South Clark Place, Arlington, VA. In addition, a CPA request may be delivered in person to the patent examining group where the prior application is assigned. All CPA requests should be clearly marked "Box CPA."

The date of receipt accorded to a CPA request sent by facsimile transmission is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or Federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or Federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia. A CPA transmitted to the Patent and Trademark Office should be transmitted to the patent examining group or art unit to which the prior application is assigned.

>In order to encourage applicants to transmit CPA requests directly to the patent examining group or art unit to which the prior application is assigned, the PTO will only acknowledge receipt of a CPA request filed by facsimile transmission where the CPA request is transmitted directly to the patent examining group or art unit to which the prior application is assigned. Applicants filing a CPA by facsimile transmission may include a "Receipt for Facsimile Transmitted CPA" (PTO/SB/29A) containing a mailing address and identifying information (e.g., the prior application number, filing date, title, first named inventor) with the request for a CPA. The PTO will: (1) separate the "Receipt for Facsimile Transmitted CPA" from the CPA request papers; (2) date-stamp the "Receipt for Facsimile Transmitted CPA"; (3) verify that the identifying information provided by the applicant on the "Receipt for Facsimile Transmitted CPA" is the same information provided on the accompanying request for a CPA; and (4) mail the "Receipt for Facsimile Transmitted CPA" to the mailing address provided on the "Receipt for Facsimile Transmitted CPA." The "Receipt for Facsimile Transmitted CPA" cannot be used to acknowledge receipt of any paper(s) other than the request for a CPA. A returned "Receipt for Facsimile Transmitted CPA" may be used as *prima facie* evidence that a request for a CPA containing the identifying information provided on the "Receipt for Facsimile Transmitted CPA" was filed by facsimile transmission on the date stamped thereon by the PTO. As the PTO will verify only the identifying information contained on the request for a CPA, and will not verify whether the CPA was accompanied by other papers (e.g., a preliminary amendment), the "Receipt for Facsimile Transmitted CPA" cannot be used as evidence that papers other than a CPA were filed by facsimile transmission in the PTO. Likewise, applicant-created "receipts" for acknowledgment of facsimile transmitted papers (whether created for the acknowledgment of a CPA or other papers) cannot be used as evidence that papers were filed by facsimile in the PTO. Applicants are cautioned not to include information on a "Receipt for Facsimile

ile Transmitted CPA" that is intended for retention in the application file, as the PTO does not plan on retaining a copy of such receipts in the file of the application.<

An applicant filing a CPA by facsimile must include an authorization to charge the basic filing fee to a deposit account, or the application will be treated under 37 CFR 1.53(f) as having been filed without the basic filing fee (as fees cannot otherwise be transmitted by facsimile).

37 CFR 1.6(f) provides for the situation in which the Office has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. 37 CFR 1.6(f) requires that a showing thereunder include, *inter alia*, a copy of the sending unit's report confirming transmission of the application or evidence that came into being after the complete transmission of the application and within one business day of the complete transmission of the application.

The Certificate of Mailing Procedure under 37 CFR 1.8 does not apply to filing a request for a CPA, since the filing of such a request is considered to be a filing of national application papers for the purpose of obtaining an application filing date (**>37 CFR 1.8(a)(2)(i)(A)<). Thus, if (1) the Patent and Trademark Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to *>reply< and (2) a petition for a three-month extension of time (and the fee) and a CPA are received in the Patent and Trademark Office on January 5, 1998 (Monday), accompanied by a certificate of mailing under 37 CFR 1.8 dated January 2, 1998 (Friday), then the prior application was abandoned on January 3, 1998, and the CPA is improper because the CPA was not filed before the abandonment of the prior application. As a further example, if (1) the Patent and Trademark Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to *>reply< and (2) applicant submits a petition for a three-month extension of time (and the fee) and a CPA request via facsimile transmission accompanied by a certificate of transmission under 37 CFR 1.8 at 9:00 PM (PST) on January 2, 1998 (Friday), but the Patent and Trademark Office does not receive the complete transmission until 12:01 AM (EST) on January 3, 1998 (Saturday), then the CPA is improper because the CPA request was not filed until January 5, 1998, see 37 CFR 1.6(a)(3), which is after the abandonment (midnight on Friday, January 2, 1998) of the prior application.

FILING FEE

The filing fee for a CPA is: (1) the basic filing fee as set forth in 37 CFR 1.16; and (2) any additional fee required by 37 CFR 1.16 based on the number of claims remaining in the application after entry of any amendment accompanying the CPA and entry of any amendments under 37 CFR

1.116 not entered in the prior nonprovisional application which applicant has requested to be entered in the CPA. See 37 CFR 1.53(d)(3).

A general authorization to charge fees to a deposit account which was filed in the prior application carries over from the prior nonprovisional application to a CPA. Thus, where a general authorization to charge fees to a deposit account was filed in the prior application the patent examining group should charge the necessary filing fee of the CPA to the deposit account. Because small entity status does not automatically carry over from the prior application to the CPA, unless the request for a CPA specifically indicates that the filing fee is to be charged in the small entity amount, the large entity filing fee should be charged.

Where a general authorization to charge fees to a deposit account was filed in the prior application and applicant desires to file a CPA without paying the filing fee on the filing date of the application, applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application.

Where a filing date has been assigned to a CPA, but the basic filing fee is insufficient or has been omitted, applicant will be so notified by the patent examining group and given a period of time in which to file the missing fee and to pay the surcharge set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application. The time period usually set is 2 months from the date of notification. This time period is subject to the provisions of 37 CFR 1.136(a). A CPA will not be placed upon the files for examination until all of its required parts, including the filing fee and surcharge, if necessary, are received. See 37 CFR 1.53(h). Thus, it would be inappropriate to conduct an interview or to issue an action on the merits in the CPA until the filing fee and surcharge, if necessary, are received.

EXTENSIONS OF TIME

If an extension of time is necessary to establish continuity between the prior application and the CPA, the petition for extension of time should be filed as a separate paper directed to the prior nonprovisional application. However, a CPA is not improper simply because the request for a CPA is combined in a single paper with a petition for extension of time. The "separate paper" requirement of 37 CFR 1.53(d)(2) is intended to preclude an applicant from burying a request for a CPA in a paper submitted primarily for another purpose, e.g., within an amendment after final for the prior application.

While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application, a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (i.e., expressly abandon) the prior application. Thus, it will be considered

a "reply" for purposes of 37 CFR 1.136(a)(3). As a result, an authorization in the prior application to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees to a deposit account will be treated as a constructive petition for an extension of time in the prior application for the purpose of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

If an extension of time directed to the prior application is filed as a separate paper, it must be accompanied by its own certificate of mailing under 37 CFR 1.8 (if mailed by first class mail) or under 37 CFR 1.10 (if mailed by Express Mail), if the benefits of those rules are desired.

NOTICE OF CPA FILING

Since a "Notice of Abandonment" is not mailed in the prior application as a result of the filing of a CPA nor is a filing receipt normally sent for a CPA, the examiner should advise the applicant that a request for a CPA has been granted by including Form Paragraph 2.30 in the first Office action of the CPA.

¶ 2.30 CPA Status Acceptable

The request filed on [1] for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. [2] is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this paragraph in the first Office action of a CPA to advise the applicant that a request for a CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA.
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number of the parent application.

A "conditional" request for a CPA will not be permitted. Any "conditional" request for a CPA submitted as a separate paper with an amendment after final in an application will be treated as an unconditional request for a CPA of the application. This will result (by operation of 37 CFR 1.53(d)(2)(v)) in the abandonment of the prior application, and (if so instructed in the request for a CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. The examiner should advise the applicant that a "conditional" request for a CPA has been treated as an unconditional request for a CPA and has been accepted by including Form Paragraph 2.35 in the first Office action of the CPA.

¶ 2.35 CPA Status Acceptable - Conditional Request

Receipt is acknowledged of the "conditional" request for a Continued Prosecution Application (CPA) filed on [1] under 37 CFR 1.53(d) based

on prior Application No. [2]. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this paragraph in the first Office action of a CPA to advise the applicant that a "conditional" request for a CPA is treated as an unconditional request and the CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA.
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number ** identified in the CPA request.<

Where the examiner recognizes that a paper filed in the prior application contains a request for a CPA, but the request is not in a separate paper, the examiner should, if possible, contact applicant by telephone to notify applicant that the request for a CPA is ineffective or notify the applicant in the next Office action that the CPA request is ineffective by using Form Paragraph 2.31.

¶ 2.31 CPA Status Not Acceptable - Request Not on Separate Paper

Receipt is acknowledged of the request for a Continued Prosecution Application (CPA) filed on [1] under 37 CFR 1.53(d) based on Application No. [2]. However, because the request was not submitted on a separate paper as required by 37 CFR 1.53(d)(2), the request is not acceptable and no CPA has been established.

Examiner Note:

1. Use this paragraph to inform applicant that a request for a CPA is not in compliance with 37 CFR 1.53(d)(2) and, therefore, no CPA has been established.
2. In bracket 1 insert the filing date of the paper containing the request for a CPA.
3. In bracket 2 insert the Application Number ** identified in the CPA request.

INVENTORSHIP

The inventive entity set forth in the prior nonprovisional application automatically carries over into the CPA UNLESS the request for a CPA is accompanied by or includes on filing a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the CPA. 37 CFR 1.53(d)(4). The statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to 37 CFR 1.33(b) to sign an amendment in the continuation or divisional application. The examiner should acknowledge receipt of a statement filed with a CPA requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the CPA in the first Office action in the CPA by using Form Paragraph 2.32.

¶ 2.32 Request To Delete a Named Inventor

Receipt is acknowledged of the statement requesting that [1] be deleted as a named inventor which was filed with the Continued Prosecution Application (CPA) on [2]. The inventorship has been corrected as requested.

Examiner Note:

1. Use this paragraph where a Continued Prosecution Application (CPA) is filed accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. Any request to delete a named inventor in a CPA filed after the CPA is filed must be accompanied by a petition under 37 CFR 1.48.
2. In bracket 1 insert the name or names of the inventor(s) requested to be deleted.
3. In bracket 2 insert the filing date of the CPA.

After the first Office action is mailed, the application file should be sent to OIPE for revision of its records to reflect the change of inventorship. The examiner should note the change of inventorship on the original oath or declaration by writing in red ink in the left column "See Paper No. ___ for inventorship changes." See MPEP § 201.03 and § 605.04(g). Any request by applicant for a corrected filing receipt to show the change in inventorship should not be submitted until after the examiner has acknowledged the change in inventorship in an Office action. Otherwise, the "corrected" filing receipt may not show the change in inventorship.

The inventive entity of the CPA will be the same as the inventive entity of the prior application even if the CPA papers include a transmittal letter or a new oath or declaration naming an inventor not named in the prior application. However, the new oath or declaration will be placed in the application file. Upon review of the application, the examiner will notify the applicant in the first Office action using Form Paragraph 2.33 that the inventive entity of the prior application has been carried over into the CPA. If the inventive entity set forth in the transmittal letter of the new oath or declaration is desired, then a petition under 37 CFR 1.48 along with the required fee set forth in 37 CFR 1.17(i) must be filed. No new oath or declaration need be filed with the later-filed petition under 37 CFR 1.48 if such was submitted on filing of the CPA. If a petition under 37 CFR 1.48 is not filed, it should be noted that the filing in a CPA of a transmittal letter or a new oath or declaration containing an inventor not named in the prior nonprovisional application may result in the claims in the CPA being rejected under 35 U.S.C. 102(f).

¶ 2.33 New Inventor Identified

It is noted that [1] identified as a named inventor in the Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) on [2], but no petition under 37 CFR 1.48, as is required, was filed to correct the inventorship. Any request to add an inventor must be in the form of a petition under 37 CFR 1.48. Otherwise, the inventorship in the CPA shall be the same as in the prior application.

Examiner Note:

1. Use this paragraph where a request for a Continued Prosecution Application (CPA) identifies one or more inventors who were not named as inventors in the prior application on the filing date of the CPA.
2. In bracket 1 insert the name or names of the inventor(s) requested to be added followed by either --was-- or --were--, as appropriate.
3. In bracket 2 insert the filing date of the CPA.

No inventor may be added to a CPA except by way of a petition under 37 CFR 1.48. Also, after the filing date of the CPA, no inventor may be deleted in a CPA, except by way of a petition under 37 CFR 1.48. A petition for correction of inventorship under 37 CFR 1.48 filed in the prior nonprovisional application, but not considered in the prior nonprovisional application at the time the CPA is filed, will be considered in the CPA.

BENEFIT OF EARLIER FILING DATE

A request for a CPA is a specific reference under 35 U.S.C. 120 to every application assigned the application number identified in the request, and 37 CFR 1.78(a)(2) provides that a request for a CPA is the specific reference under 35 U.S.C. 120 to the prior application. That is, the CPA includes the request for an application under 37 CFR 1.53(d) and the recitation of the application number of the prior application in such request is the "specific reference to the earlier filed application" required by 35 U.S.C. 120. No further amendment to the specification of the CPA is required by 35 U.S.C. 120 or 37 CFR 1.78(a) to identify or reference the prior application, as well as any other application assigned the application number of the prior application (e.g., in instances in which a CPA is the last in a chain of CPAs).

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See *Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application.

In the situation in which there is a chain of CPAs, each CPA in the chain will, by operation of 37 CFR 1.53(d)(7), contain the required specific reference to its immediate prior application, as well as every other application assigned the application number identified in such request. Put simply, a specific reference to a CPA by application number and filing date will constitute a specific reference to: (1) the non-continued prosecution application originally assigned such application number (the prior application as

to the first CPA in the chain); and (2) every CPA assigned the application number of such non-continued prosecution application.

Where the non-continued prosecution application originally assigned such application number itself claims the benefit of a prior application or applications under 35 U.S.C. 120, 121, or 365(c), 37 CFR 1.78(a)(2) continues to require that such application contain in its first sentence a reference to any such prior application(s). As a CPA uses the specification of the prior application, such a specific reference in the prior application (as to the CPA) will constitute such a specific reference in the CPA, as well as every CPA in the event that there is a chain of CPAs.

Where an applicant in an application filed under 37 CFR 1.53(b) seeks to claim the benefit of a CPA under 35 U.S.C. 120 or 121 (as a continuation, divisional, or continuation-in-part), 37 CFR 1.78(a)(2) requires a reference to the CPA by application number in the first sentence of such application. 37 CFR 1.78(a)(2) provides that "[t]he identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number." Thus, where a referenced CPA is in a chain of CPAs, this reference will constitute a reference under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every CPA in the chain as well as the non-continued prosecution application originally assigned such application number.

Therefore, regardless of whether an application is filed under 37 CFR 1.53(b) or (d), a claim under 35 U.S.C. 120 to the benefit of a CPA is, by operation of 37 CFR 1.53(d)(7) and 37 CFR 1.78(a)(2), a claim to every application assigned the application number of such CPA. In addition, applicants will not be permitted to choose to delete such a claim as to certain applications assigned that application number (e.g., for patent term purposes). See 37 CFR 1.53(d)(7).

Further, an applicant in a CPA is not permitted to amend the first sentence of the specification to provide a specific reference to the prior application. Any such amendment will not be entered. The applicant should be advised in the next Office action that any such amendment to the specification has not been entered by using Form Paragraph 2.34.

¶ 2.34 Reference in CPA to Prior Application

The amendment filed [1] requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a [2] application of Application No. [3] has not been entered. As set forth in 37 CFR 1.53(d)(7), a request for a CPA is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. Thus, there is no need to amend the first sentence of the specification to refer back to the prior application and any such amendment shall be denied entry.

Examiner Note:

1. Use this paragraph to inform the applicant that an amendment to the first sentence of the specification referring to the CPA as a continuing application of the prior application has not been entered and will not be entered if submitted again.
2. In bracket 1, insert the filing date of the amendment.
3. In bracket 2, insert either --continuation-- or --divisional--.
4. In bracket 3, insert the Application Number of the prior nonprovisional application.

Claims under 35 U.S.C. 119(a)-(e) for the benefit of the filing dates of earlier applications in a parent application will automatically carry over to a CPA.

WAIVER OF CONFIDENTIALITY

A CPA is construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to obtain access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of 37 CFR 1.53(d) may be given similar access to, copies of, or similar information concerning, the other application(s) in the application file. 37 CFR 1.53(d)(6). However, all applications in the file jacket of a pending CPA are treated as pending, rather than abandoned, in determining whether copies of, and access to, such applications will be granted. 37 CFR 1.14(a)(3)(iv). See MPEP § 103 for further discussion of access to an abandoned application contained in the file of a pending CPA.

CERTIFIED COPY

A certified copy of a CPA will be prepared by the Certification Branch upon request. The certified copy will consist of a copy of the most recent non-continued prosecution application in the chain of CPAs. The filing date of the CPA will be shown in the certified copy as the filing date of the most recent non-continued prosecution application in the chain of CPAs.

SMALL ENTITY STATUS

Small entity status established in the parent application does not automatically carry over to a CPA. Status as a small entity must be specifically established in every application in which the status is available and desired. However, 37 CFR 1.28(a)(2) provides that in any continuing application, including a CPA, status as a small entity may be established simply by paying the basic filing fee in the small entity amount. If payment of the basic filing fee in the small entity amount is made in a CPA, it would not be necessary to file a new statement or a copy of the prior statement. The payment of the small entity basic filing fee will be treated as a reference to the statement in the prior application.

TERMINAL DISCLAIMER

A terminal disclaimer filed in the parent application carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the same application number as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA. See MPEP § 1490, "Withdrawing a Terminal Disclaimer," subheading entitled "A. Before Issuance of Patent."

PRIOR ELECTION

An election made in the prior application carries over to the CPA only if all of the following conditions are met: (1) the CPA is designated as a continuation or is not designated at all (i.e., the CPA is **NOT** designated as a divisional); (2) there was an express election by the applicant in reply to a restriction requirement in the prior application; (3) the CPA presents claim(s) drawn only to invention(s) claimed in the prior application; and (4) the CPA does not contain an indication that a shift in election is desired.

Where all of the conditions are met, the examiner's first action should repeat the restriction requirement made in the prior application to the extent it is still applicable in the CPA and include a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application.

INFORMATION DISCLOSURE STATEMENTS

All information disclosure statements filed in the prior application that comply with the content requirements of 37 CFR 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.

In addition, all information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within three months of the filing date of a CPA will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that

point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is 3 months from the filing date of the CPA, any information contained in an information disclosure statement complying with 37 CFR 1.98, and filed within that 3-month window must be considered by the examiner. Since a CPA requires less processing time than a file wrapper continuing application under former 37 CFR 1.62, it should be expected that a first Office action will normally issue in a CPA well within three months from the filing date of the CPA request. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution and result in the loss of patent term. Therefore, applicants are encouraged to file any information disclosure statement in a CPA as early as possible, preferably before the first Office action. For further discussion of information disclosure statements, see MPEP § 609.

COPIES OF AFFIDAVITS

Affidavits and declarations, such as those under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application, automatically become a part of the CPA. Therefore, no copy of the original affidavit or declaration filed in the parent nonprovisional application need be filed in the CPA.

FORMS

Form PTO/SB/29, "Continued Prosecution Application (CPA) Request Transmittal" and Form PTO/SB/29A, "Receipt For Facsimile Transmitted CPA" may be used by applicant for filing a CPA under 37 CFR 1.53(d). The forms used by the patent examining groups to notify applicants of defects regarding applications filed under 37 CFR 1.53(d) are shown below. "Notice of Improper Application, No Filing Date Granted" Form PTO-2011; "Notice of Improper CPA Filing Under 37 CFR 1.53(d), No Filing Date Granted" Form PTO-2012; "Notice To File Missing Parts Of Application (CPA), Filing Date Granted" Form PTO-2021; "Notice Of Incomplete Reply (CPA) (Filing Date Granted)" Form PTO-2018; and "Notice Of Abandonment Under 37 CFR 1.53(f) (CPA) (Filing Date Granted)" Form PTO-2019.

201.06(d)

MANUAL OF PATENT EXAMINING PROCEDURE

Please type a plus sign (+) inside this box → ☐

PTO/SB/29 (2/99)
 Approved for use through 09/30/2000. OMB 0651-0032
 Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 C.F.R. § 1.53(d))

CHECK BOX, if applicable:

☐ DUPLICATE

Address to:

Assistant Commissioner for Patents
 Box CPA
 Washington, DC 20231

Attorney Docket No.

First Named Inventor

Examiner Name

Group / Art Unit

Express Mail Label No.

This is a request for a ☐ continuation or ☐ divisional application under 37 C.F.R. § 1.53(d),
 (continued prosecution application (CPA)) of prior application number _____ / _____,
 filed on _____, entitled _____.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. § 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. § 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. § 154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. § 1.53(d), but must be filed under 37 C.F.R. § 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 C.F.R. § 1.14 to access to copies of, or information concerning, the prior application may be given similar access to copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referring to the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request. 37 C.F.R. § 1.78(e).

1. ☐ Enter the unentered amendment previously filed on _____ under 37 C.F.R. § 1.116 in the prior nonprovisional application.
2. ☐ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. § 1.53 (d)(4).
 - a. ☐ DELETE the following inventor(s) named in the prior nonprovisional application:

 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
 - a. ☐ PTO-1449
 - b. ☐ Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

TYPES, CROSS-NOTING, AND STATUS OF APPLICATION

201.06(d)

PTO/SB/29 (8/98)
 Approved for use through 09/30/2000. OMB 0651-0032
 Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| CLAIMS | (1) FOR | (2) NUMBER FILED | (3) NUMBER EXTRA | (4) RATE | (5) CALCULATIONS |
|---|---------|------------------|------------------|---|------------------|
| TOTAL CLAIMS (37 C.F.R. § 1.16(c) or (j)) | | -20* = | | x \$ _____ = | \$ _____ |
| INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b) or (i)) | | -3** = | | x \$ _____ = | \$ _____ |
| MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d)) | | | | + \$ _____ = | \$ _____ |
| | | | | BASIC FEE (37 C.F.R. § 1.16) | \$ _____ |
| | | | | Total of above Calculations = | \$ _____ |
| | | | | Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27 & 1.28). | \$ _____ |
| | | | | * Release claims in excess of 20 and over original patent. ** Release independent claims over original patent. | TOTAL = \$ _____ |

6. Small entity status:

a. ☐ A small entity statement is enclosed, if (b) and (c) do not apply.

b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.

c. ☐ Is no longer claimed.

7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. _____:

a. ☐ Fees required under 37 C.F.R. § 1.16.

b. ☐ Fees required under 37 C.F.R. § 1.17.

c. ☐ Fees required under 37 C.F.R. § 1.18.

8. ☐ A check in the amount of \$ _____ is enclosed.

9. ☐ New Attorney Docket Number, if desired _____
(Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.)

10 a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)

b. ☐ Return Receipt Postcard (Should be specifically itemized. See MPEP 503)

11. ☐ Other: _____

NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

| 12. NEW CORRESPONDENCE ADDRESS | | | | | |
|--|-----------|---|--|--|--|
| <input type="checkbox"/> Customer Number or Bar Code Label | | <input type="checkbox"/> New correspondence address below | | | |
| (Insert Customer No. or Attach bar code label here) | | | | | |
| Name | | | | | |
| Address | | | | | |
| City | State | Zip Code | | | |
| Country | Telephone | Fax | | | |

| 13. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED | |
|---|--|
| Name (Print / Type) | |
| Signature | |
| Registration No. (Attorney/Agent) | |
| Date | |

201.06(d)

MANUAL OF PATENT EXAMINING PROCEDURE

Approved for use through 09/30/2000. OMB 0651-0032
 Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | |
|--|--|--|
| If this RECEIPT is included with a request for a CPA filed by facsimile transmission, it will be date stamped and mailed to the ADDRESS in Item 1. | | RECEIPT FOR FACSIMILE TRANSMITTED CPA (To be completed and filed by the Contingent Protection Applicant (CPA) in accordance with 37 CFR 1.214) |
| 1. ADDRESS | Applicant's Mailing Address for this receipt <i>must</i> be CLEARLY PRINTED or TYPED in the box below. | |
| <p>NOTE: By this receipt, the PTO (a) acknowledges that a request for a CPA was filed by facsimile transmission on the date stamped below by the PTO and (b) verifies only that the application number provided by the applicant on this receipt is the same as the application number provided on the accompanying request for a CPA. This receipt CANNOT be used to acknowledge receipt of any paper(s) other than the request for a CPA.</p> | | |
| <p>2. APPLICATION IDENTIFICATION: (Provide at least enough information to identify the application)</p> <p>a. For prior application</p> <p>Application No:</p> <p>Filing Date:</p> <p>Title:</p> <p>Attorney Docket No:</p> <p>First Named Inventor:</p> <p>b. For instant CPA application</p> <p>New Attorney Docket No: (If applicable)</p> | | |
| <p>The PTO date stamp, which appears in the box to the right, is an acknowledgement by the PTO of receipt of a request for a CPA filed by facsimile transmission on the date indicated below.</p> | | (THIS AREA FOR PTO DATE STAMP USE) |
| <p>PTO HANDLING INSTRUCTIONS:</p> <p>Please stamp area to the right with the date the complete transmission of the request for a CPA was received in the PTO and also include the PTO organization name that provided the date stamp (stamp may include both items). Verify that the application number provided by applicant on this receipt is the same as the application number provided by applicant on the request for a CPA accompanying this receipt. If there is an inconsistency between the application number provided on this receipt and the request for a CPA, strike through the inconsistent application number provided on this receipt and insert the correct application number, if possible. Then place in a window envelope and mail.</p> | | |

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

TYPES, CROSS-NOTING, AND STATUS OF APPLICATION

201.06(d)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE OF IMPROPER APPLICATION
No Filing Date Granted

The above-identified application was deposited as an application under 37 CFR 1.62; however, 37 CFR 1.62 practice has been abolished. Applications purporting to be an application under 37 CFR 1.62 are treated as having been filed under 37 CFR 1.53(d) as a continued prosecution application. 37 CFR 1.53(d) requires that a continued prosecution application be a continuation or divisional application (not a continuation-in-part application), and does not permit the introduction of subject matter that would have been new matter in the prior application. The above-identified application does not meet the requirements of 37 CFR 1.53(d) to be accepted as a continued prosecution application as it is a continuation-in-part application.

As the above-identified application cannot be accepted as an application under 37 CFR 1.53(d), applicant is advised to file a petition under 37 CFR 1.53(e) and \$130.00 petition fee (37 CFR 1.17(i)) to have the above-identified application accepted under 37 CFR 1.53(b). Unless the above-identified application was deposited with a complete specification, including claims, all drawings described in the specification and a signed oath or declaration in compliance with 37 CFR 1.63, the petition under 37 CFR 1.53(e) must also be accompanied by: (1) a true copy of the complete prior application as originally filed, including the specification, drawings and signed oath or declaration; (2) any amendments entered in the prior application; any amendments submitted but not entered in the prior application and directed to be entered in the 37 CFR 1.62 application papers; and (4) a signed oath or declaration in compliance with 37 CFR 1.63 and the surcharge required by 37 CFR 1.16(e). The true copy of the prior application, any amendments entered in the prior application or not entered in the prior application but directed to be entered on the filing date of the above-identified application, and any preliminary amendment submitted with the 37 CFR 1.62 application papers will constitute the original disclosure of the resulting application under 37 CFR 1.53(b).

Any assertion that the above-identified application may be accepted as an application under 37 CFR 1.53(d), or any request to have the above-identified application accepted as an application under 37 CFR 1.53(b), must be by way of petition under 37 CFR 1.53(e) directed to the attention of the Office of Petitions. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition. A petition under 37 CFR 1.53(e) as discussed above must be submitted within TWO MONTHS of the date of this notice (37 CFR 1.181(f)) or the application may be returned or otherwise disposed of and the filing fee, if submitted, will be refunded less the \$130.00 handling fee (37 CFR 1.21(n)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.

A copy of this notice MUST be returned with the reply.

Direct the reply and any questions about this notice to:

_____, Examining Group _____

(703) 30 _____

FORM PTO-2011 (Rev 1/98)

PART 1 - ATTORNEY/APPLICANT COPY



UNITED STATES DEPARTMENT OF COMMERCE
 Patent and Trademark Office
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

| | | | |
|--------------------|--------------------|-----------------------|------------------------|
| APPLICATION NUMBER | FILED/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|--------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE OF IMPROPER CPA FILING UNDER 37 CFR 1.53(d)
No Filing Date Granted

The Continued Prosecution Application (CPA) request deposited on _____ is improper under 37 CFR 1.53(d) and has not been granted a filing date for reason(s) indicated below:

Any assertions that the above-mentioned CPA request is proper under 37 CFR 1.53(d) must be by way of petition directed to the attention of the Office of Petitions. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

Any petition must be submitted within **TWO MONTHS** of the date of this notice (37 CFR 1.181(f)) or the application may be returned or otherwise disposed of and the filing fee, if submitted, will be refunded less the \$130.00 handling fee (37 CFR 1.21(n)). **THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.**

- ☐ 1. The prior application is not a complete (37 CFR 1.51(b)) application or the national stage of a PCT international application that is in compliance with 35 U.S.C. 371.
- ☐ 2. The request for a CPA was not filed before the payment of the issue fee on the prior application. The issue fee was paid on the prior application on _____.
- ☐ 3. The request for a CPA was not filed before the abandonment of, or termination of proceedings on, the prior application. The prior application was abandoned, or proceedings terminated on _____.
- ☐ 4. A petition under 37 CFR 1.136(a) and appropriate fee are necessary to establish copendency between this CPA and the prior application.
- ☐ 5. OTHER:

A copy of this notice MUST be returned with the reply.

Direct the reply and any questions about this Notice to:

Examining Group _____

(703) 30 _____

**>



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

| | | | |
|--------------------|----------------------|-----------------------|--------------------------|
| APPLICATION NUMBER | FILING /RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO/TITLE |
|--------------------|----------------------|-----------------------|--------------------------|

DATE MAILED:

NOTICE TO FILING MISSING PARTS OF APPLICATION (CPA)
Filing Date Granted

The Continued Prosecution Application (CPA) request filed on _____ is entitled to a filing date under 37 CFR 1.53(d)(1). The CPA request, however, lacks the filing fee(s) and/or items indicated below.

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the fee(s), item(s), and any surcharge required below to avoid abandonment of this CPA. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.138(a).

The total amount owed by applicant is the sum of items 1(a) or (b), 2, and 3 (if checked) below.

- ☐ 1. The statutory basic filing fee is:
- ☐ missing.
 - ☐ insufficient.

(a) Applicant must submit \$_____ to complete the basic filing fee and the \$130.00 surcharge set forth in 37 CFR 1.18(e) (non-small entity), or \$_____ to complete the basic filing fee as a small entity and the \$85.00 surcharge set forth in 37 CFR 1.18(e) and file a small entity statement under 37 CFR 1.27 claiming such status (if the prior application was entitled to small entity status and such status is still proper and desired, a new small entity statement is not required (37 CFR 1.26)).

(b) Applicant must submit \$_____ to complete the basic filing fee as a small entity and the \$85.00 surcharge set forth in 37 CFR 1.18(e).

- ☐ 2. Additional claim fees of \$_____ (non-small entity) or \$_____ (small entity) for _____ independent claims over 3. \$_____ (non-small entity) or \$_____ (small entity) for _____ claims over 20. \$_____ (non-small entity) or \$_____ (small entity) for multiple dependent claim surcharge.

Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.

- ☐ 3. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21 (m)).
- ☐ 4. The CPA request is unsigned. Applicant must file a signed duplicate or ratification of the CPA request.
- ☐ 5. Other: _____

A copy of this Notice MUST be returned with the reply.

Direct the reply and any questions about this Notice to:

Examining Group _____

(703) 30 _____



UNITED STATES DEPARTMENT OF COMMERCE
 Patent and Trademark Office
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

| | | | |
|--------------------|--------------------|-----------------------|-----------------------|
| APPLICATION NUMBER | FLING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY DOCKET NO./TITLE |
|--------------------|--------------------|-----------------------|-----------------------|

DATE MAILED:

NOTICE OF INCOMPLETE REPLY (CPA)
(Filing Date Granted)

The reply filed on _____ to the Notice to File Missing Parts of Application (CPA)
 (Notice) mailed on _____ has been entered into the application. The reply, however,
 is incomplete for the following reason(s):

- ☐ 1. The filing fee required by the Notice has not been received. The amount of \$ _____ is due.
- ☐ 2. The surcharge of \$ _____ has not been received.
- ☐ 3. The reply does not include _____

_____ as required by the Notice.

A complete reply must be timely filed to prevent **ABANDONMENT** of the above-identified application.

The period for reply remains as set forth in the Notice. You may, however, obtain an **EXTENSION OF TIME** under the provisions of 37 CFR 1.136(a) by filing a petition accompanied by the appropriate fee (37 CFR 1.17(a)).

A copy of this notice MUST be returned with the reply.

Direct the reply and any questions about this Notice to

Examining Group _____

(703) 30_____- _____

FORM PTO-2018 (Rev 12/97)

PART 1 - ATTORNEY/APPLICANT COPY

TYPES, CROSS-NOTING, AND STATUS OF APPLICATION

201.06(d)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|--------------------|---------------------|-----------------------|------------------------|
| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE OF ABANDONMENT UNDER 37 CFR 1.53(f) (CPA)
(Filing Date Granted)

The above-identified Continued Prosecution Application (CPA) is abandoned for failure to timely or completely reply to the Notice to File Missing Parts of Application (CPA) (Notice) mailed on _____.

- ☐ No reply was received.
☐ The reply received on _____ was untimely.
☐ The reply received on _____ was incomplete. The reply did not include:

- ☐ 1. The surcharge required for filing the basic filing fee on a date later than the filing date of a nonprovisional application (37 CFR 1.16(e)).
☐ 2. The basic filing fee required by the Notice (37 CFR 1.16 (a), (f), (g), (h)).
(Note: A nonprovisional application may not be relied on for benefits under 35 U.S.C. 120 and 37 CFR 1.78 unless the processing and retention fee set forth in 37 CFR 1.21(l) is paid within the one year period set forth in 37 CFR 1.53(f)).
☐ 3. The additional claims fee and/or multiple dependent claims fee required by the Notice (37 CFR 1.16(b), (c), (d), (i), (j)).

☐ The letter of Express Abandonment filed on _____ is acknowledged; however, the application is abandoned for failure to timely or completely reply to the Notice as indicated above.

A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(c).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(c).

Any questions concerning petitions to revive should be directed to "Office of Petitions" at (703) 305-9282.

Examining Group _____

(703) 30 _____

FORM PTO-2019 (Rev 12/97)

PART 1 - ATTORNEY/APPLICANT COPY

Exhibit B 37 CFR 1.53(d)

MPEP 7th Ed., Rev. 1, Feb. 2000

§ 1.52

MANUAL OF PATENT EXAMINING PROCEDURE

§ 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic reproduction by use of digital imaging and optical character recognition. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See § 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification when required by the Office.

(b) Except for drawings, the application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in this part) and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper, with the claim or claims commencing on a separate sheet and the abstract commencing on a separate sheet. See §§ 1.72(b) and 1.75(h). The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced. The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. See § 1.84 for drawings.

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration

referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(d) An application may be filed in a language other than English. An English translation of the non-English-language application, a statement that the translation is accurate, and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

[43 FR 20462, May 11, 1978; paras. (a) and (d), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; para. (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) and (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a), (c) & (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.53 Application number, filing date, and completion of application.

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is

the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1) or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section,

(i) Provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earliest of:

(A) Abandonment of the application filed under paragraph (b) of this section;

(B) Payment of the issue fee on the application filed under paragraph (b) of this section;

(C) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or

(D) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(ii) The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under paragraph (b) of this section.

(3) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is either:

(A) Complete as defined by § 1.51(b); or

(B) The national stage of an international application in compliance with 35 U.S.C. 371; and

(ii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(b)(5) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in § 1.16; and

(ii) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application.

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph

who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

- (i) Title of invention;
- (ii) Name of applicant(s); and
- (iii) Correspondence address.

(9) Envelopes containing only requests and fees for filing an application under this paragraph should be marked "Box CPA." Requests for an application under this paragraph filed by facsimile transmission should be clearly marked "Box CPA."

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification

that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph. Any petition under this paragraph must be accompanied by the fee set forth in § 1.17(i) in an application filed under paragraphs (b) or (d) of this section, and the fee set forth in § 1.17(q) in an application filed under paragraph (c) of this section. In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing - Nonprovisional (including continued prosecution) application.* If an application which has been accorded a filing date pursuant to paragraph (b) of this section, including a continuation, divisional, or continuation-in-part application, does not include the appropriate filing fee or an oath or declaration by the applicant pursuant to § 1.63 or § 1.175, or, if an application which has been accorded a filing date pursuant to paragraph (d) of this section does not include the appropriate filing fee, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to file the fee, oath or declaration, and the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application may be disposed of. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (e) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, the oath or declaration in an application under paragraph (b) of this section, and the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(g) *Completion of application subsequent to filing - Provisional application.* If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(c)(1), applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to file the fee, cover sheet, and the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. If the required filing fee is not timely paid, the application may be disposed of. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (e) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet, and the surcharges set forth in § 1.16(l) in order to prevent abandonment of the application.

(h) *Subsequent treatment of application - Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; paras. (c) and (d), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; paras. (b) and (c), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 63 FR 5734, Feb. 4, 1998, effective Feb. 4, 1998, 63 FR 36184, July 2, 1998, effective July 2, 1998]

§ 1.54 Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d).

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other situations, before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in § 1.17(i). If the certified copy is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her